REMARKS

35 U.S.C.§103 - Rejections

Claims 1-5, 7-9, 13-17, 19-30, 35-36 and 39-41 stand rejected under 35 U.S.C. §

103(a) as being unpatentable over U.S. Patent Number 6,618,727 by Wheeler et al.

(hereinafter "Wheeler") in view of U.S. Patent Number 6,718,324 by Edlund et al.

(hereinafter "Edlund").

In regards to claim 1, the Examiner states:

> Edlund, however, teaches 'generating a list of one or more related
> documents ranked based upon relevance to a first representation of
> content associated with a first field of a reference' as the search engine
> returns search results based on the original query. These search results
> are typically sorted ascending or descending based on content relevance
> (col. 8, lines 37-39).

Office Action, page 3.

Applicants respectfully disagree that Edlund discloses this limitation of claim 1. Claim 1

states:

> 1. A method, comprising:
>   generating a list of one or more related documents ranked based
> upon relevance to a first representation of content associated with a first
> field of a reference extensible markup language document, the first
> representation including a set of terms and one or more weighted values
> associated with each term in the set of terms; and
>   generating a link to each of the one or more related documents.
> (Emphasis Added).

Applicant respectfully submits that Edlund dos not disclose, "generating a list of one or

more related documents ranked based upon relevance to a first representation of

content associated with a first field of a reference extensible markup language

document." In contrast, Edlund merely discloses an Internet search engine that ranks results of the search based on relevance to the user. See Abstract. Edlund does not disclose that the list of related documents is based on relevance to a <u>first representation of content associated with a first field</u> of a reference XML document. Edlund uses the criteria of tracked characterics of a user to determine a relevance rating. Edlund does not disclose basing relevance on <u>content associated with a</u> document. Also, Edlund explicitly mentions that the Internet is made up of web site using the HTML format. Edlund, col. 1, lines 44-58. Further, the html format is the only markup language disclosed by Edlund. Hence, Edlund is completely silent on extensible markup language ("XML") documents.

Again, Edlund does not disclose that the list of related documents is based on relevance to a <u>first representation of content associated with a first field</u> of a reference XML document. In contrast, Edlund merely discloses an intermediate matching search result of a keyword search in an index list of information. Col. 3, lines 25-27. Search results based on relevance to one or more keywords is not the same as a results in the form of a list of related documents based on relevance to a first representation of content associated with a first field of a reference XML document. Edlund is completely silent about the search criteria being based on a relevance to a first representation of content associated with a first field of a reference XML document. Therefore, Edlund fails to disclose this limitation of claim 1.

Applicants also submit that Wheeler fails to disclose, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language

document. Wheeler is completely silent on this limitation. In fact, the Examiner specifically states, "Wheeler does not explicitly teach generating a list of one or more related documents ranked based upon relevance to a first representation of content." Office Action, page 3. Wheeler merely discloses a method of detecting and scoring similarities between documents in a source database and a search criterion. See Abstract. Therefore, Wheeler fails to disclose this limitation of claim 1.

Furthermore, even if Wheeler and Edlund were combined, such a combination would lack "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." By way of contrast, the combination of Wheeler and Edlund would disclose a method for detecting and scoring similarities between documents by generating a list of relevant documents to the keywords in the search string.

Therefore, in view of the above distinction, neither Wheeler nor Edlund, individually or in combination, disclose each and every limitation of claim 1. As such, claim 1 is not rendered obvious by Wheeler in view of Edlund under 35 U.S.C. § 103(a).

Applicant respectfully submits that Wheeler does not suggest a combination with Edlund, and Edlund does not suggest a combination with Wheeler because Wheeler specifically teaches away from such a combination. It would be impermissible hindsight to combine Wheeler with Edlund based on applicants' own disclosure.

Independent claims 13, 21, 24 and 27 also include the limitation, "generating a list of one or more related documents ranked based upon relevance to a first

representation of content associated with a first field of a reference extensible markup language document." As stated above in regards to claim 1, the combination of Wheeler and Edlund do not disclose this limitation. Therefore, the combination of Wheeler and Edlund do not make claims 12, 21, 24 and 27 obvious under 35 U.S.C. §103(a).

In regards to independent claims 29, 35 and 39 the Examiner states, "Executing a query on content from a [sic] active desktop window without a user having to request the query (col. 19, lines 60-64 and Fig. 24)." Office Action, page 7. Applicants respectfully disagree that Wheeler discloses this element of claims 29, 35 and 39. In contrast, Wheeler merely discloses a first document is annotated with a scoring method which becomes a query used to search a second document. Col. 19, lines 60-64. Wheeler is completely silent on the first document being content from an active desktop window. Further, Wheeler does not disclose that the query is run without a user having to request the query. In fact, Wheeler discloses that the user must initiate the query. Applicants submit that a first document that is annotated with a scoring algorithm which becomes a query used to search a second document is not the same as executing a query on content from an active desktop window without a user having to request the query. Therefore, Wheeler fails to disclose this limitation of independent claims 29, 35 and 39.

Applicants also submit that Edlund fails to disclose, "executing a query on content from an active desktop window without a user having to request the query." In fact, Edlund is completely silent on this limitation. Edlund discloses an Internet search engine that returns results in ascending or descending order based on relevance of the

search query entered by a user. See abstract. Hence, Edlund fails to disclose this limitation.

Furthermore, even if Wheeler and Edlund were combined, such a combination would lack "executing a query on content from an active desktop window without a user having to request the query." By way of contrast, the combination of Wheeler and Edlund would disclose a method for detecting and scoring similarities between documents by generating a list of relevant documents to the keywords in the search string.

Therefore, in view of the above distinction, neither Wheeler nor Edlund, individually or in combination, disclose each and every limitation of independent claims 29, 35 and 39. As such, claims 29, 35 and 39 are not rendered obvious by Wheeler in view of Edlund under 35 U.S.C. § 103(a).

Applicant respectfully submits that Wheeler does not suggest a combination with Edlund, and Edlund does not suggest a combination with Wheeler because Wheeler specifically teaches away from such a combination. It would be impermissible hindsight to combine Wheeler with Edlund based on applicants' own disclosure.

Dependent claims 2-5, 7-9, 14-17, 19-20, 22-23, 25-26, 28, 30, 36 and 40-41 all depend from and include the limitations of independent claims 1, 13, 21, 24, 27, 29, 31, 35 and 39, respectively. Therefore the combination of Wheeler and Edlund also fails to make claims 2-5, 7-9, 14-17, 19-20, 22-23, 25-26, 28, 30, 36 and 40-41obvious under 35 U.S.C. §103(a).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,618,727 by Wheeler et al. (hereinafter "Wheeler") in view of U.S. Patent 6,718,324 by Edlund et al. (hereinafter "Edlund") as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36 and 39-41 above and in view of U.S. Patent Number 5,675,819 by Schuetze (hereinafter "Schuetze").

As stated above, the combination of Wheeler and Edlund fails to disclose all the limitations of claim 1, which claim 10 depends upon and includes the limitations of. Specifically, Wheeler and Edlund fail to disclose, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Applicants also submit that Schuetze fails to disclose this limitation of claim 1. Schuetze is completely silent on, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." In contrast, Schuetze accesses relevant documents based on a query through comparing word vectors and documents vectors. Therefore, the combination of Wheeler, Edlund and Schuetze fails to make claim 10 obvious under 35 U.S.C. §103(a).

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,618,727 by Wheeler et al. (hereinafter "Wheeler") in view of U.S. Patent 6,718,324 by Edlund et al. (hereinafter "Edlund") as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36 and 39-41 above and in view of U.S. Patent Number 5,983,216 by Kirsch et al. (hereinafter "Kirsch").

As stated above, the combination of Wheeler and Edlund fails to disclose all the limitations of claim 1, which claims 11 and 12 depend upon and include the limitations of. Specifically, Wheeler and Edlund fail to disclose, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Applicants also submit that Kirsch fails to disclose this limitation of claim 1. Kirsch is completely silent on, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Therefore, the combination of Wheeler, Edlund and Kirsch fails to make claims 11 and 12 obvious under 35 U.S.C. §103(a).

Claims 18, 33, 34, 38 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,618,727 by Wheeler et al. (hereinafter "Wheeler") in view of U.S. Patent 6,718,324 by Edlund et al. (hereinafter "Edlund") as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36 and 39-41 above and in view of U.S. Patent Number 6,592,627 by Agrawal et al. (hereinafter "Agrawal").

As stated above, the combination of Wheeler and Edlund fails to disclose all the limitations of independent claims 13, 29, 35 and 39 which claims 18, 33, 34, 38 and 43 depend upon and include the limitations of. Specifically, Wheeler and Edlund fail to disclose, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Applicants also submit that Agrawal fails to

disclose this limitation. Agrawal is completely silent on, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Therefore, the combination of Wheeler, Edlund and Agrawal fails to make claims 18, 33, 34, 38 and 43 obvious under 35 U.S.C. §103(a).

Claims 31, 32, 37 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,618,727 by Wheeler et al. (hereinafter "Wheeler") in view of U.S. Patent 6,718,324 by Edlund et al. (hereinafter "Edlund") as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36 and 39-41 above and in view of U.S. Patent Publication Number 2003/0084040 by Jeffrey (hereinafter "Jeffrey").

As stated above, the combination of Wheeler and Edlund fails to disclose all the limitations of independent claims 29, 35 and 39 which claims 31, 32, 37 and 42 depend upon and include the limitations of. Specifically, Wheeler and Edlund fail to disclose, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Applicants also submit that Jeffrey fails to disclose this limitation. Jeffrey is completely silent on, "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document." Therefore, the combination of Wheeler, Edlund and Jeffrey fails to make claims 31, 32, 37 and 42 obvious under 35 U.S.C. §103(a).
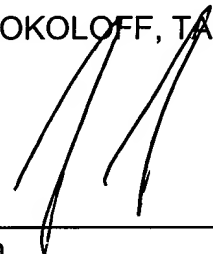
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Conclusion

It is respectfully submitted that in view of the amendments and remarks set forth herein, the rejections and objections have been overcome. Applicants reserve all rights with respect to the application of the doctrine equivalents. If there are any additional charges, please charge them to our Deposit Account No. 02-2666. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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